



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,734	10/16/2003	Enrique David Sancho	2062.001US3	1773

21186 7590 03/12/2010
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

3685

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

03/12/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com
request@slwip.com

Office Action Summary	Application No. 10/688,734	Applicant(s) SANCHO, ENRIQUE DAVID	
	Examiner JOHN M. WINTER	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-36 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-36 and 40-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/19/2009, 1/11/2009, 2/5/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on November 24, 2009 is hereby acknowledged, 34-36, 40 and 43-44 remain pending.

Response to Arguments

2. The Applicant states that Pare's passage does not teach a first server receiving a computer fingerprint file identifying a user computer based on information associated with a plurality of components included in the user computer.

The Examiner responds that Pare discloses an identification module that utilizes “biometric data and PIN; biometric data alone; digital identification (digital certificates); PIA hardware identification code” (Column 11, lines 14-21) to identify a party the Examiner submits that at least the feature of “PIA hardware identification code” is analogous to the claimed limitation of “identifying a user computer based on information associated with a plurality of components included in the user computer”.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 34-36 and 43-44 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
4. Claims 34-36 are rejected based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978);

Gottschalk v. Benson, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

5. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 34 fails prong (1) because the “tie” (e.g. receiving at a mini-server) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claims 35-36 and 43-44 are dependant upon claim 34 and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 40 recites "message containing information indicating that a user was verified" however there is no corresponding structure in either the first or second input unit that implements any verification process, and is therefore indefinite.

8. Claim 40 is indefinite because it is a hybrid claim. In particular, the claim appears to be directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention. Evidence to support an interpretation that claim 17 is a *product* is (1) the preamble which states "a vendor computer " and (2) the body of the claim which recites "a first input unit" Alternatively, evidence that indicates the claim is directed to a *process* or method is the body of the claim which recites "to communicate with a second server to receive a second server message containing information indicating that a user was verified, based on a first identification for the user, generated using the first computer fingerprint file. . . ." Because of this conflicting evidence, it is unclear if claim 17 is a product or process claim. See the 35 U.S.C. §101 rejection above. See MPEP §2173.05(p) II or Ex Parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990). For prior art purposes, the Examiner interprets the claim as being drawn to a product claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-36, 40 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare Jr. et al. (US Patent 6,269,348) in view of Glass et al. (US Patent 6,332,193).

9. As per claims 34 and 40

Pare Jr. et al ('348) a computer-implemented method for verifying a user and a user computer comprising:

receiving at a first server a first message from the user computer, the first server message including a first computer fingerprint file; (Column 11, lines 14-21 and 39-42)
identifying the user computer based on information associated with a plurality of components included in the user computer;(column 12,lines 28-42) comparing the first computer fingerprint file against a second computer fingerprint file to verify the user computer,(Column 15, lines 35-49) the second computer fingerprint file including information associated with the plurality of components included in the user computer, and the second fingerprint file being accessible by the first server; (Column 11, lines 39-45)

Pare Jr. et al ('348) does not specifically disclose "receiving at a second server the second message from the user computer, the second server message including the a first identification for the user, the first identification being associated with based on the first computer fingerprint file identifying the user computer; and comparing, at the second server, the first identification for the user against a second identification for the user to verify the user, the second identification for the user accessible by the second server; and after the comparing of the first identification for the user against the second identification for the user to verify the user, generating a third server message at the second server based upon the results of the comparison"; Glass et al ('193) discloses a "receiving at a second server the second message from the user computer, the second server message including the a first identification for the user, the first identification being associated with based on the first computer fingerprint file identifying the user computer; and comparing, at the second server, the first identification for the user against a second identification for the user to verify the user, the second identification for the user accessible by the second server; (Column 10, lines 30-35) and after the comparing of the first identification for the user against the second identification for the user to verify the user, generating a third server message at the second server based upon the results of the comparison. (Column 10, lines 30-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Pare Jr. et al ('348) reference in view of Glass et al ('193) in order to restrict prosecution of a transaction to a specific user/machine pair.

10. As per claim 35,

Pare Jr. et al ('348) discloses a method for verifying a user and a user computer comprising:

sending the first message to a vendor computer; and sending the second message to the vendor computer.(Column 11, lines 45-48)

11. As per claim 36,

Pare Jr. et al ('348) discloses a method according to claim 35 further comprising:

authorizing an action by the vendor computer only if both the first message contains information indicating the user computer was verified and the second message contains information indicating the user was verified.(Column 11, lines 39-42; Figure 6)

12. As per claim 43,

Pare Jr. et al ('348) discloses the method of claim 34, wherein the first mini-server and the second mini-server are associated with a clearinghouse computer. (Figure 7)

13. As per claim 44,

Pare Jr. et al ('348) discloses the method of claim 34, wherein the first mini-server is associated with a first clearinghouse computer and the second mini-server is associated with a second clearinghouse computer. (Figure 7)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3685

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685